## REMARKS

Claims 11-29 and 37-44 are presently pending in the application. In the Office Action dated July 30, 2003, claims 12, 38 and 42 were rejected under 35 U.S.C. § 112, second paragraph, because the recited limitation "if it is determined that multiple recipients have not been indicated" was said to be ambiguous. Claim 17 was rejected under § 112, second paragraph, because the limitation of "distinct indicator" was said not to be unclear because it is not specifically disclosed in the specification. Claims 11-13, 16-24, 27-29, 37-39, and 41-43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dillon (U.S. Patent No. 6,067,561) in view of Arnold (U.S. Patent No. 6,275,848). Claims 14, 15, 25, 40 and 44 were rejected under § 103(a) as being unpatentable over Dillon in view of Arnold and further in view of Foladare et al. (U.S. Patent No. 6,311,210). Claim 26 was rejected under § 103(a) as being unpatentable over Dillon in view of Arnold (and further in view of Landfield et al. (U.S. Patent No. 5,632,011).

Applicant disagrees with these grounds of rejection and wishes to clarify various distinctions of Applicant's invention over the cited art. Reconsideration is therefore requested in light of the following remarks.

### Applicant's Teaching in Comparison to the Cited Art

The disclosed embodiments of the invention will now be discussed in comparison to the prior art. Of course, the discussion of the disclosed embodiments, and the discussion of the differences between the disclosed embodiments and the prior art subject matter, do not define the scope or interpretation of any of the claims. Instead, such discussed differences merely help the Examiner appreciate important claim distinctions discussed thereafter.

Applicant discloses a method and system for securely distributing an electronic message (*i.e.*, electronic communication) to multiple individual recipients in an efficient manner using centralized storage and management. In particular, the method involves receiving an electronic message containing an indication of the recipient(s) for the message, and makes a determination whether the indication is for multiple recipients. Unlike conventional methods, the present method *makes a conditional decision that if the indication is for multiple recipients,* the system does not send the message to the recipients, but rather centrally stores the message,

and sends only a short notification of the message to each of the multiple recipients without sending the message itself. The system does not send the message to any recipient until it receives a response from at least one of the recipients that contains a request for the message. If the indication is not for multiple recipients the message is sent to the recipient without being stored. In various embodiments, the system tracks, tests and routes requests from the recipients to access the message when appropriate and deletes the stored message when all recipients have responded and therefore all have received the message, unless at least one recipient requests that message be saved.

Thus, a single copy of the message can be stored on a server computer for delivery on an individual basis to multiple recipients when requested. In various embodiments, the system also stores instructions related to a particular recipient regarding the type of notification to be performed for that particular recipient, and sends the notification according to those instructions of that particular recipient  In certain embodiments, the notification instructions are tailored by a particular recipient and in others, the notification instructions are automatically assigned for a particular recipient. In some cases the notification instructions indicate the message is to be encrypted, and the system performs the encryption accordingly. In certain embodiments, after all recipients have reviewed the message and no recipient has indicated a choice to save the message (or all have indicated a choice to delete the message) the system automatically deletes the single copy of the message. The instructions may include actions to be taken with respect to the message, such as to save or delete the message or to forward the message to another recipient.

The centralized storage and management of electronic messages to be distributed to a large number of recipients provides a variety of benefits. Because only a short indicator is sent to each recipient, the recipients' systems require only a small amount of storage space. In addition, each recipient system does not need the necessary software to save and manage the electronic messages. Instead, the recipient system need only be able to display a message and to send requests and other message action instructions to the server. In addition, central storage of the message provides easy access and control of the original message by an appropriate authorized user who may need access to the centrally message for any number of reasons (*e.g.*,

for backup, for authentication, or for modification). Removal or modification of the message to be distributed to a large number of users is therefore easily accomplished.

The cited prior art references, alone or in combination, fail to teach the combination of features of Applicant's invention in any manner that would fairly suggest or motivate one of ordinary skill in the art to create a message management system like Applicant's.

Dillon is directed to sending notifications (alerts) of Email messages to recipient's using a hybrid network that transmits notifications via a continuous high speed channel. Other than these features and in particular, the features regarding how the alerts are sent, the handling of messages as taught by Dillon is conventional in the art. In this regard, Applicant respectfully submits that the Examiner has read more into Dillon than is taught therein and/or has not properly characterized the teaching of that reference, especially in comparison to Applicant's embodiments. At paragraph 9 of the Office Action the Examiner states that: Dillon teaches:

If it is determined that multiple recipients have been indicated,       (ITEM 1)

a.   storing the Email communication, (e.g. col. 3, lines 12-65)      (ITEM 2)

b.   notifying each of the multiple recipients of the Email to communication [sic] without sending the Email communication to the recipients (e.g. col. 1, line 25 – col. 2 line 38 and col 3., lines 12-65).                   (ITEM 3)

This is not an accurate characterization of what is taught in the cited passages (or anywhere else) in Dillon.

First, and most importantly, Dillon does not teach *anything whatsoever* about storing an Email message ***conditionally*** based upon anything about the indication, (*i.e.*, **IF** it is determined that multiple recipients have been *indicated*). In this regard, the cited passages of Dillon, at most teach storing an email message if the user has not accessed the Email account, not requested the Email, or is not online. This is common in the prior art. Nothing in Dillon, teaches determining *anything* about the *indication* sent to any recipient to make a conditional decision on whether to store the Email message. Therefore the conditional aspect of Item 1 above is not taught in Dillon.

Second, Dillon does not teach determining whether multiple recipients have been indicated. The Examiner seems to acknowledge this at paragraph 10 of the Office Action where it is stated that "Dillon does not specifically teach determining whether multiple recipients of the

Email communication have been indicated in the received indication." Therefore, all of the elements of Item 1 are missing from Dillon.

Third, because Dillon is silent about indications of multiple recipients, it is axiomatic that Dillon does not teach "notifying *each of the multiple recipients* of the Email to communication [sic] without sending the Email communication to the recipients." Dillon makes no references at all to multiple recipients for the same Email communication. Therefore all the elements of Item 3 are missing from Dillon.

The only elements Dillon teaches that are relevant to Applicant's embodiments is Item 2, (storing an email message) and *part* of Item 3 (sending notification of the Email message to a recipient without sending the Email message). Accordingly, with all due respect, the Examiner's characterization of the elements taught by Dillon is not accurate. With respect to the Items above, Dillon at most teaches storing an email message and sending a notification of the message to a recipient , *e.g.*, "You've got mail. " Any prior art Email system does this.

The deficiency of Dillon is not cured by combination with Arnold. Arnold was cited for teaching "determining whether multiple recipients of the Email communication have been indicated in the received indication. (col 4, lines 25-col. 5, line 25)." Applicant acknowledges that Arnold teaches determining whether multiple recipients of the Email communication have been indicated. However, Arnold does not teach storing the Email message conditionally, based upon whether multiple recipients have been indicated. Indeed, Arnold teaches nothing at all about treating the Email message differently based upon whether multiple recipients have been indicated. What Arnold teaches at the cited passages and elsewhere, is detaching attachments from Email messages based on size (or other criteria), storing the attachment on the Internet, sending all the designated recipients the Email message devoid of the attachment, but with an embedded URL link, and allowing the recipients access to the stored attachment through the link embedded in the Email message. These features are not conditionally based on whether multiple users have been indicated or not.

Accordingly, the combination of Arnold with Dillon fails to teach or suggest the combination of elements in the various embodiments disclosed by Applicant.

In addition, the motivation for combining Arnold with Dillon stated by the Examiner is not understood by the undersigned, and in any case is not relevant because the

combination would not lead one of skill in the art to devise a method like Applicants. The motivation for combining the references stated by the Examiner is "because it would be more efficient for a system to acknowledge when multiple recipients have been indicated so if the sender needed to know which recipients did not receive an Email, the sender could resend the Email to the recipients that are missing the Email or have misplaced it." The undersigned does not understand this statement, and respectfully submits that this appears to be a motivation created by the Examiner, not derived from the references, because no such features are taught, suggested, or stated to be desirable in the systems described by Arnold and Dillon. Neither reference discusses efficiency based on whether multiple recipients have been indicated or resending Email to recipients that are missing or have misplaced the Email. These advantages are however, a benefit of Applicant's invention. It is impermissible hindsight to read the prior art in light of the disclosed invention to find a motivation in the prior art to do what Applicant has done.

Moreover, even if one would combine Arnold and Dillon for other reasons, these reasons are not relevant to Applicant's invention nor would lead one of ordinary skill in the art to the same. Dillon is directed toward sending notifications (alerts) of Email messages to recipient's using a hybrid network that transmits notifications via a continuous high speed channel, while Arnold is directed toward a method of detaching attachments from Email messages, storing the attachments on the Internet and sending a notification message with an embedded URL address for the stored attachment to the recipients. The combination of Arnold and Dillon might provide motivation to one of ordinary skill in the art to send notifications devoid of attachments described by Arnold using the continuous high speed channel taught by Dillon. This is not relevant to, and does not suggest, storing email messages conditionally based on whether there is an indication of multiple users. Therefore, even accepting the proposed motivation asserted by the Examiner, the combination of references would not yield the system described by Applicant.

**The Claims and Rejections**

Rejections under § 103. Turning now to the claims and the rejections thereof, each of base claims 11, 37 and 41 recite, in-pertinent part, "determining whether multiple

recipients of the Email communication have been indicated in the received indication; and *if it is determined that multiple recipients have been indicated, storing the Email communication; notifying each of the multiple recipients of the Email communication without sending the Email communication to the recipients.* As discussed above, this type of conditional determination of whether or not to store an Email message based on whether or not multiple recipients have been indicated is not taught or suggested by earthier Dillon or Arnold, the primary references cited by the Examiner. This important element of the claimed invention is, all together absent from the references therefore the combination does not yield the claimed invention. Moreover, the combination of references fails to provide any motivation for using such a conditional mechanism for handling Email communications. Therefore, Applicant request withdrawal rejection of the base claims 11, 37 and 41 on grounds of obviousness over Dillon and Arnold.

Each of the remaining claims 12-29, 38-40 and 42-44 depend from an allowable base claim and are patentable at least for that reason. Applicant therefore also requests withdrawal of the rejections these claims on grounds of obviousness. –This is not an admission that patentability of any of these dependent claims rises and falls with the independent claims. Rather this expedient is used herein in the interest of brevity. Applicant reserves the right to further distinguish the dependent claims over Dillon, Arnold, Foladare and Landfield at a later time if necessary.

Rejections under § 112. Claims 12, 38 and 42 were rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. In particular, the Examiner asserted that the limitation of "if it is determined that multiple recipients have not been indicated" is not specifically disclosed and that the meaning of "indicated" seems to be ambiguous for the reasons that when it is used in other claims, it would seem to have different meanings/functions.

Applicant respectfully disagrees with the Examiner's rejections on this ground. Claims 12, 38 and 42 depend from claims 11, 37 and 41, respectively, each of which recite in-part, "determining whether multiple recipients of the Email communication have been indicated..." Claim 12 as originally filed recites "if it is determined that multiple recipients have not been indicated.." It is clear that what is "indicated" in the base claims is whether or not there are multiple recipients. Claims 12, 38 and 42 recite an action taken on the condition that

multiple recipients are *not* indicated. Applicant submits that this is not ambiguous. The Examiner did not explain, nor does the Applicant understand, what is meant by the statement that "indicated" may have different meanings/functions in different claims. Applicant submits it is clear from the context of each claim, what is being indicated, and therefore request withdrawal of the rejection of claims 12, 38 and 42 on this ground.

Claim 17 was rejected as being indefinite because the meaning of the limitation "distinct indicator" was not specifically disclosed in the specification. Applicant submits that the term need not be specifically disclosed in the specification to be clear, rather what the specification discloses need only be clearly captured by the term. Claim 12 recites "notifying of a recipient of the Email communication [*i.e.*, the original Email message] involves sending a distinct indicator Email communication. [*i.e.*, a different Email message distinct from the first]" It is clear from the language (and from the specification, for example, on page 5, lines 12-16) that the indicator in this case, is itself an Email message, but one that is distinct from the original Email message about which it indicates. Applicants therefore request withdrawal of the rejection of claim 17 on this ground.

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a timely Notice of Allowance are earnestly solicited.

Respectfully submitted,

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